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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,163	09/13/2000	Steven A. Weiss	30083-pa	7517

7590 06/04/2002

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EXAMINER
NGUYEN, KIM T

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/661,163	Weiss
Examiner	**Art Unit**
Kim Nguy n	3714

-- The MAILING DATE of this communication appears on the cover sh t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jan 2, 2002*

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-25* is/are pending in the applica

4a) Of the above, claim(s) *24 and 25* is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

The amendment filed on January 2, 2002 (paper No. 7) has been received and considered. By this amendment, claim 8 has been canceled, claims 20-25 have been added and claims 1-7 and 9-25 are pending in the application.

Election/Restriction

1. Newly submitted claims 24-25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-23, drawn to a game with subsequent events, classified in class 463, subclass 10.

II. Claims 24-25, drawn to transfer outcome from one game to another, classified in class 463, subclass 43.

Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, a game with subsequent events of Group I does not require transferring outcome from one game to another of Group II. The subcombination has separate utility such as importing game result from one game to another game.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-25 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-7, and 9-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falciglia (US. Patent No. 5,935,002) in view of Tsumura (US. Patent No. 5,547,202).

a. As per claim 1-4, Falciglia discloses a method for gaming. The method comprises the steps of: making a wager (col. 4, lines 57-58); evoking chance means to produce outcomes and displaying the outcomes (col. 4, lines 52-55 and col. 5, lines 25-40); comparing each outcome to an ultimate winning outcome (col. 2, lines 22-27); triggering a subsequent event (col. 6, lines 3-22); determining whether the plurality of outcomes match an intermediate winning outcome

and awarding the intermediate winning (col. 6, lines 1-6); and continuing to evoke chance means until the ultimate winning outcome is produced or the outcomes are exhausted (col. 5, lines 21-24 and col. 6, lines 7-10).

Falciglia does not disclose saving the current set of outcomes on encoded movable media. However, Tsumura discloses saving information of a suspended game (col. 11, lines 19-42). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the saving method of Tsumura to the game method of Falciglia in order to allow a user to resume playing a suspended game as motivated by Tsumura in col. 11, lines 29-32.

b. As per claim 5, Falciglia discloses awarding complimentary items (col. 6, lines 64-66).

c. As per claim 6-7, 10 and 13, Falciglia discloses a subsequent gaming event and awarding credits (col. 7, lines 14-35).

d. As per claim 8, 11, and 14, Falciglia discloses allowing the player to select a subset of outcomes (col. 9, lines 26-28), generating outcomes (col. 9, lines 53-55); comparing the selected subset of outcomes with the generated outcomes (col. 9, lines 39-47; and col. 10, lines 2-5); and awarding credits (col. 10, lines 6-14).

e. As per claim 9, 12, 15, and 21, Falciglia does not disclose simulating a racing event or keno gaming event. However, activating a racing event or a keno event as subsequent game events would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the

time the invention was made to include a racing event or keno gaming event in the subsequent games of Falciglia in order to allow the player to play a racing or keno bonus game.

f. As per claim 16-17, Falciglia discloses a game which involves a single player (Fig. 1) or a plurality of players (Fig. 4 and col. 1, lines 49-52).

g. As per claim 18, Falciglia discloses a three dimensional RxC matrix (Fig. 1).

h. As per claim 19, refer to discussion in claim 1 above.

i. As per claim 20, 22, and 23, refer to discussion in claims 1 and 8 above.

Response to Arguments

3. Applicant's arguments filed 2/19/2002 have been fully considered but they are not persuasive.

a) In response to applicant's argument in page 7, second, third and fourth paragraphs, Falciglia does not teach saving the game for later use. However, Tsumura teaches the claimed limitation (col. 11, lines 19-42). Tsumura does not teach a wager game machine. However, Tsumura teaches a gaming machine which accepts coin from the player as admitted by applicant in page 7, third paragraph, an ordinary skill in the art would be able to apply saving the game for later use as taught by Tsumura to the game machine of Falciglia. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only

knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

b) In response to applicant's argument in page 8, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine references is found in the knowledge generally available to one ordinary skill in the art.

c) In response to applicant's argument in page 9, first paragraph, the claimed limitations in claims 5-8, 10-11, and 13-14, are taught by Falciglia as explained in 35 USC 103(a) rejection above. Further, racing game and keno game are very well known games in the art.

d) In response to applicant's argument in page 9, third paragraph, Falciglia does allow the player to select outcomes (col. 9, lines 26-28), col. 2, lines 23-27 teaches the claimed limitation generating outcomes in claim 20, line 14 of the present application.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this final action should be mailed to:

Box AF:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9303, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 308-7768 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Plaza II, Arlington. VA., Second Floor (Receptionist).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:00 am to 5:30 pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703)872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1148.

Joe H. Cheng
Primary Examiner

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May 31, 2002